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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,008	01/08/2002	Bernard Cuenoud	4-30970A	1967

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CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

EXAMINER

KIFLE, BRUCK

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,008

Applicant(s)

CUENOUD ET AL.

Examiner

Bruck Kifle, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,19-21,26-29,31-36 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) 38-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17,19-21,26-29,31,32,34-36 and 41-45 is/are allowed.
- 6) ☒ Claim(s) 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Applicant's amendments and remarks filed 09/03/04 have been received and reviewed. Claims 17, 19-21, 26-29, 31-36 and 38-45 are now pending in this application.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The amendments filed 09/03/04 have been entered.

Claims 17, 19-21, 26-29, 31, 32, 34-36 and 41-45 are allowed.

Claims 38-40 are withdrawn from consideration. Applicant's arguments are not on point. These claims lack unity of invention. This application is a 371 of PCT/EP00/05058. Compounds, corresponding compositions, a method of use and a process of making that are of the **same** scope are considered to form a single inventive concept under PCT Rule 13.1, 37 CFR 1.475(d). Claims 38-40 are not so linked as to form a single inventive concept. These claims are of different scope, raise different issues of patentability (such as, synergy) and require separate searches in the literature.

Claim Rejections - 35 USC § 112

Claim 33 is again rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's arguments have been fully considered but not found persuasive. The basis of this rejection is the same as given in the previous office actions and is incorporated herein fully by reference.

The how to use portion of the statute has not been addressed. This means that Applicants must teach the skilled practitioner, in this case a physician, how to treat a given subject. The

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physician clearly must know what disease and what symptoms is to be treated. In a case concerning the patentability of compounds with "good effects against a wide range of insects" *In re LORENZ AND WEGLER*, 134 USPQ 312 U.S. Court of Customs and Patent Appeals upheld the rejection of compound claims, noting that "[a]ppellants are seeking a seventeen year monopoly. We would remind them that if they have in truth invented something which promotes the progress of science and the useful arts, then in exchange for a patent grant they must make a full and complete disclosure of their invention, leaving nothing to speculation or doubt. That Congress so intended is evident from the strong and comprehensive language of Section 112 which appellants here have failed to satisfy." In this case, Applicants have not provided what is being treated by claim 33, who the subject is, how one can identify said subject (i.e. how one can identify a subject in need), given no specific dose, given no specific dosing regimen, given no specific route of administration, and do not specify what diseases or symptom they intend to treat.

In a case, *In re MOUREU AND CHOVIN*, 145 USPQ 452, concerning the patentability of antitubercular compounds, The U.S. Court of Customs and Patent Appeals held "[i]t is therefore clear that those skilled in the art who desire to use the products of the invention for medicinal purposes would find it necessary to engage in extensive experimentation to determine what would be the effective and safe manner of using the products as medicines for the suggested purposes and to determine the dosages to be avoided because lethal or ineffective. Both the examiner and the board recognized that compliance with section 112 does not necessarily require specific recitations of use if the method of using is inherent in the description of the compound, *In re Nelson*, 47 CCPA 1031, 280 F.2d 172, 126 USPQ 242. The board held, however, that a

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bald assertion that the claimed compounds possess antitubercular activity would not indicate to those skilled in the medical arts the manner of effectively using the compounds.”


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 571-272-0668. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
September 15, 2004